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In re Application of
INSEL, Paul, A., et al.
U.S. Application No.: 09/402,244
PCT No.: PCT/US98/23496
International Filing Date: 04 November 1998
Priority Date: 10 November 1997
Attorney's Docket No.: 220002058901

For: METHODS AND COMPOSITIONS FOR
IDENTIFYING VARIATIONS IN HUMAN α_B
AND β_2 ADRENERGIC RECEPTOR GENES

DECISION ON REQUEST
FOR CHANGE IN
INVENTORSHIP

This decision is issued in response to applicants' "Request For Change In Inventorship Under 37 CFR 1.497(d) filed on 21 May 2001. Applicants have paid the required fee.

BACKGROUND

On 04 November 1998, applicants filed international application PCT/US98/23496 which claimed a priority date of 10 November 1997 and which designated the United States. The published international application identified Paul A INSEL, Volker HERRMANN, and Ranier BUESCHER as the inventors.

On 18 May 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 10 May 2000.

On 29 September 1999, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 12 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required. The Notification also informed applicants that the failure to submit these materials within one month of the date of the Notification would result in abandonment of the application.

On 12 December 2000, applicant filed a response which included the required small entity surcharge and a declaration executed by the three inventors identified in the international application, as well as a fourth inventor, Stephen B. LIGGETT.

On 20 April 2001, the DO/EO/US mailed a Notification Of A Defective Response (Form PCT/DO/EO/916) and a Notification Of A Defective Oath Or Declaration (Form PCT/DO/EO/917) indicating that the declaration filed on 12 December 2000 was defective because it included an inventor not included in the international application.

On 21 May 2001, applicants filed the request considered herein. The request seeks to correct the inventorship so as to include the fourth inventor, Stephen B. LIGGETT.

DISCUSSION

37 CFR 1.497(d) states:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).

Here, as noted above and in the Form PCT/DO/EO/917, the declaration filed on 12 December 2000 names an inventive entity different from that set forth in the international application. Specifically, it includes one inventor (Stephen B. LIGGETT) who was not listed on the international application. Accordingly, before the declaration filed on 12 December 2000 can be accepted, applicants must submit the materials set forth in 37 CFR 1.497(d).

Applicants' 21 May 2001 submission satisfies all the requirements of 37 CFR 1.497(d). Applicants have submitted the required fee and a statement from the added inventor, Stephen B. LIGGETT. Because no assignment has been recorded regarding this application and the petition is silent as to the existence of an assignee, it is presumed that no assignee exists (MPEP, § 201.03D). If this presumption is incorrect, applicants **must** inform this Office immediately.

CONCLUSION

Applicants' request for correction of inventorship is **GRANTED**. Inventor Stephen B. LIGGETT is hereby added as the fourth inventor in the present application.

Based on this corrected inventorship, the declaration filed on 12 December 2000 is now acceptable under with 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The 35 U.S.C. 371 date is 12 December 2000.



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